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Practitioner's Docket No. LAR 16091-1

PATENT APPLICATION

OFFICIAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Christopher S. Welch and Daniel F. Perey

Application No.: 10/662,161

Examiner: Stevenson, Andre C.

Filed: September 11, 2003

Art Unit: 2812

For: Optically Stimulated Electron Emission Contamination Monitor And Method

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

CERTIFICATE OF FACSIMILE

I hereby certify that the correspondence detailed below is being transmitted to the centralized facsimile number, (703) 872-9306, in care of the Commissioner for Patents, Alexandria, VA 22313-1450 on the date shown below.

Response to Restriction Requirement - 11 pages

2/27/04
Date

Elaine C. McMahon
Elaine C. McMahon

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RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the Office Action mailed January 29, 2004, and the corrections to the Office Action telefaxed to Applicants on 2/17/2004, in which action a requirement for restriction was made under 35 U.S.C. § 121, the Applicants respond as follows:

The Examiner has required restriction between what he believes to be distinct inventions. Specifically, the Examiner stated:

- Restriction to one of the following inventions is required under 35 U.S.C. § 121:
- I. Claims 1 through 22 and 41 through 53 are drawn to an inspection apparatus, classified in class 257, subclass 48.
 - II. Claims 23 through 40 are drawn to a method on inspection, classified in class 438, subclass 17.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as system and method of its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another materially different process, (MPEP § 806.05(e)). In this case the apparatus for inspection can be practiced by an entirely different method than that claimed in Group III (sic).

In response thereto, Applicants respectfully traverse this restriction requirement on two grounds. First, Applicants traverse this restriction requirement on the ground that the two listed Groups are so closely related to one another that examining all of the claims in a single application would not be a serious burden upon the Examiner. To the contrary, it is respectfully contended that it would be more efficient, practical and expeditious to examine the inventions together in one application, rather than two.

Second, the Examiner is respectfully referred to MPEP § 806.05(e), which section specifically states that: "The burden is on the Examiner to provide reasonable examples that recite material differences." Because the Examiner has provided no such examples, the restriction is respectfully traversed on this ground as well.

However, should the Examiner uphold this restriction requirement then the Applicants hereby provisionally elect Group I, Claims 1 through 22 and 41 through 53 for examination. Additionally, should the restriction requirement be upheld it is understood that Claims 23-40 will be withdrawn from consideration as directed to a non-elected invention, and will be subject to reinstatement in the event the


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requirement for restriction is withdrawn. Applicants reserve the right to file a divisional application on any claims withdrawn from consideration.

A summary document with the status of all claims and the text of all pending claims is attached.

Respectfully submitted,



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